REMARKS

A check for four month extension of time accompanies this response. Any fees that may be due in connection with the filing of this paper or with this application may be charged to Deposit Account No. 06-1050. If a Petition for Extension of Time is needed, this paper is to be considered such Petition.

Claims 1, 2, 5, 6, 10, 15, 17, 18, 22, 25, 34, 38, 43, 44, 46, 47, 55, 56, 63, 66-68, 75, 77-79, 81, 110, 116, 118, 120, 137, 139, 140, 143-147, 150-153, 155-161, 163, 164, and 166-173 are pending. Claims 82, 95-97, 99-102, 106,107, 127, 128, 130-134, which are drawn to non-elected subject matter, are cancelled without prejudice or disclaimer without prejudice or disclaimer.

Claims in groups 2 and 4 are retained pending considering of the arguments for traversal as between these groups. Applicant expressly reserves the right to file a divisional application(s) to any cancelled or non-elected subject matter. All claims are retained in view of the traversal of the restriction requirement and for possible rejoinder. Claims in elected Group1 that read on non-elected species are retained for possible rejoinder. Also as discussed below aspects of the species election are not species per se. For example, the molecules detected by performing the method (i.e. the biomolecules) cannot be elected, since the biomolecules identified result from performing the method. If one knows the outcome of the method before performing it, there would be no need to perform the method.

Claim 1 is amended to render it clear that the method is assessing interactions of moiety "Y." Basis for this amendment can be found, for example, at page15, line, 29 - page 16, line 4. Basis also can be found, for example, in Figure 30 and at pages 49-50:

> In another embodiment, the analytical process (Figure 30) is simple and highly amenable to automation. First, a protein mixture from the cells of interest is incubated with a capture compound in buffer conditions which retain the native structural features of the proteins. The selectivity function reversibly interacts and comes to equilibrium with those proteins for which it has an affinity. The reactivity function then forms a covalent bond irreversibly linking the compound to those proteins for which there was an affinity.

Claim 150 is amended for clarity. No new matter is added.

TRAVERSAL OF THE RESTRICTION REQUIREMENT

Applicant respectfully traverses the restriction requirement as between groups 2 and groups 4. It respectfully is submitted that groups 2 and 4 are as a subcombination/combination.

Inventions that are related as a combination and subcombination are distinct and restriction may be proper ***only if*** it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability ***and*** (2) the subcombination has utility by itself or in other combinations. See MPEP 808.05(c). In this instance for group 2, claim 81, is directed to a collection of capture compounds, and group 4 is directed to a system that includes the collection of compounds, software, and other elements. Hence group 4, which includes group 2 plus addition elements is a combination, and group 2 is a subcombination thereof. In this instance, the combination as claimed ***does*** require the particulars of the subcombination (a collection) for patentability. Therefore, restrictions as between groups 2 and 4 is improper.

Also, if the restriction requirement is maintained as between groups 2 and 4, applicant ultimately could be granted a patent that includes claims to the systems includes the collections and a patent that includes a claim directed to the collections, that expire on different dates and that can be owned by different entities. As between such claims in the two patents, non obvious-type double patenting could not be found. For example, if the claims to the collections issued, obviousness-type double patenting could not be found as between that patent and claims to the system that includes the collections and a mass spectrometer and a computer with software.

Attention is directed to MPEP 806, paragraph 3, which states:[w]here inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, if restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made where related inventions as claimed are not distinct. See, also MPEP 804.01, which states:

> 35 U.S.C. § 121, third sentence, provides that wherein the Office requires restriction, the patent of either the parent or any divisional application thereof conforming to the requirement cannot be used as a reference against the other. This apparent nullification of double patenting as ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same inventions in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

Traversal of the election of species

Applicant respectfully traverses the requirement for election of species. Election of species is appropriate as between a genus and a species encompassed therein. Election of species is a search tool based in which a species is elected and searched. If art that

anticipates or obviates the claim, then the genus is unpatentable; if not art is identified, the search continues on other species until art is identified or until a conclusion that the genus is novel and unobvious is reached. This process is based on the premise that a species always anticipates a genus. For an election of species to be proper the identified species must really be a species, such that art that anticipates the species anticipates the genus. Election of a specie of biomolecule detected by virtue of practice of the method is not appropriate for an election of species. First, it is constrained by the elected compound(s) and the sample tested. Second, the detected biomolecule is the result of practicing the method, and is identified by practicing the method. The claimed method is designed to assess interactions of Y, which is a drug, drug fragment, drug intermediate, drug metabolite or prodrug in order to identify the biomolecules, as yet unknown, that interact with Y. If one knows the outcome of the method, then there is no reason to practice the method. In order to be fully responsive, applicant has elected a particular molecule and a particular capture compound for which the experiment has been performed, but so-limiting the claims results in a method that will not yield any information. Furthermore, a claimed method, should not be limited by it result; it unduly limits the method. Potential infringers who practice the method would be excluded from liability because they perform the method to discover something new. Therefore, it respectfully is submitted that the election of a species of biomolecule as presently set forth is not proper.

In addition, the election by Applicant of the so-called species of the method that does not include a step of digestion, is not to be construed that a claim that is silent regarding a step of digestion does not encompass embodiments that further include a step of digestion. Similarly, electing a species that does not include a re-design step, is *not* to be construed that a claim that does *not* recite a step of further redesigning a molecule whose interactions are assess, does *not* encompass such embodiments. Such embodiments are encompassed (see, *e.g.*, claim 143). Redesign can be effected by any method; the claims do not recite a particular method; it is not possible nor meaningful to elect a particular method of re-design. If claim 1, which does not recite a step of re-design, is deemed patentable, then a dependent claim encompassed thereby, will be patentable.

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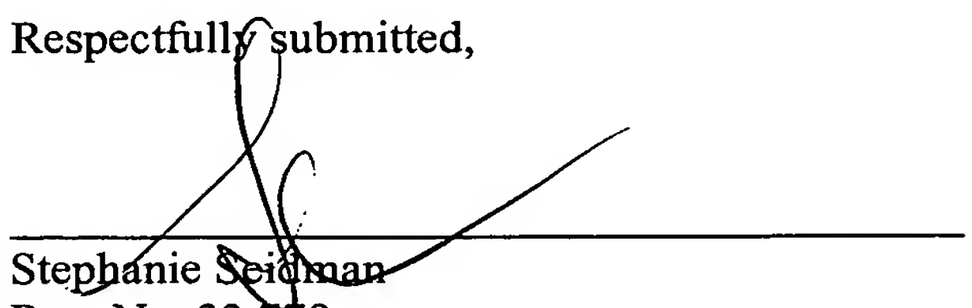
In view of the provisional election, amendments and remarks herein, modification of the requirement for restriction, removal of the election of species and examination on the merits are respectfully requested.

Respectfully submitted,



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